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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/730,597	12/08/2003	Shawn B. Benson	26083-CNT3	4554

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Suite 400  
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EXAMINER
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PIERCE, WILLIAM M

ART UNIT	PAPER NUMBER
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3711

DATE MAILED: 05/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/730,597

Applicant(s)

BENSON, SHAWN B.

Examiner

William M Pierce

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 08 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

WILLIAM M. PIERCE  
PRIMARY EXAMINER

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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**DETAILED ACTION*****Claim Objections***

Claims 4 and 27 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Claim 4 restates limitations already found in claim 3. Claim 27 recites only intended use and fails to further limit the structure of the previously claimed invention.

***Double Patenting***

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 1-27 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-10 of prior U.S. Patent No. 5,997,412. This is a double patenting rejection. While it is clear that the pending claims call for the limitation of, "configured for maintaining the integrity of the shaft as an integral member", this is inherent in '412. Note that the claiming of a new use, new function or property which is inherently present in the prior art does not necessarily make the claim patentable. *In re Best*, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977).

The scope of the structure claimed are interpreted as identical since the limitation of "configured for maintaining integrity..." is considered functional and does not further limit the claimed invention. A reliable test for double patenting under 35 U.S.C. 101 is whether a claim in the application could be literally infringed without literally infringing a corresponding claim in the patent. *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970). Is there an embodiment of the invention that falls within the scope of one claim, but not the other? If there is such an embodiment, then identical subject matter is not defined by both claims and statutory double patenting would not exist. As in the instant case the scope of the pending claims fall within those already patented since it is well recognized that claims may be differently worded and still define the same invention.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Oum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thornton*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

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A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-27 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-19 of copending Application No. 10/304,517. Although the conflicting claims are not identical, they are not patentably distinct from each other because the use of set screws to prevent movement between detachable parts is known.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-27 are rejected under 35 U.S.C. 102(b) as being anticipated by Hunter.

Column Containing Claim Limitations	Column Containing How Limitation Met by Prior art
<p>1. An extensible golf club comprising:</p> <p><b>a club head;</b></p> <p><b>a handle; and</b></p> <p><b>a shaft coupled to the club head and the handle, the shaft including at least one spacer segment operable to selectively adjust the length of the shaft, and configured for maintaining the integrity of the shaft as an integral member.</b></p> <p>2...wherein the at least one spacer segment is <b>removably attachable</b> to the shaft.</p>	<p>14 of Hunter.</p> <p>2</p> <p>11</p> <p>21</p> <p>Inherently section 22 of the shaft of Napolitano functions to set and adjust the length of the shaft and maintain its integrity.</p> <p>Shown in fig. 2.</p>

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<p><b>removably attachable to the shaft.</b></p> <p>3...wherein the at least one spacer segment includes a <b>female portion and a male portion</b> for coupling to a <b>first portion and a second portion of the shaft.</b></p> <p>4...wherein the at least one spacer segment is <b>configured for coupling with a first portion and a second portion of the shaft.</b></p> <p>5...wherein the at least one spacer segment includes <b>one spacer segment.</b></p> <p>6...wherein the at least one spacer segment includes a <b>plurality of spacer segments.</b></p> <p>7...wherein each of said spacer segments is <b>configured for coupling with one of:</b></p> <p>a) a spacer segment and a portion of the shaft; or</p> <p>b) <b>two spacer segments.</b></p> <p><b>8. An extensible golf club comprising:</b></p> <p><b>a shaft formed of a first portion and a second portion; and at least one spacer member configured for coupling the first shaft portion to the second shaft portion and configured for maintaining the integrity of the shaft as an integral member when the first and second shaft portions are coupled thereto.</b></p> <p>9...wherein the at least one spacer member includes a first end including a <b>female-type receiving port and a second end including a male-type connector.</b></p> <p>10...wherein the at least one spacer member <b>includes one spacer member.</b></p>	<p>24 and 25 respectively</p> <p>12 and 22 respectively</p> <p>See fig. 2 and reference numbers 12 and 22 respectively.</p> <p>Shown in fig. 2.</p> <p>Shown in fig. 2.</p> <p>Shown in fig. 2</p> <p>See examiners treatment of claims 1 and 3 above.</p> <p>Elements 24 and 25 respectively.</p> <p>Shown in fig. 2</p> <p>Shown in fig. 2.</p>
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<p>11...wherein the female-type receiving port on the spacer member is <b>configured for engaging a correspondingly configured male portion on the first shaft portion and the male-type connector is configured for engaging a correspondingly configured female receiving portion of the second shaft portion.</b></p> <p>12...wherein the at least one spacer member includes a <b>plurality of spacer members.</b></p> <p>13...wherein the female-type receiving port on the spacer member is <b>configured for engaging a correspondingly configured male portion on either of the first shaft portion or a spacer member, and the male-type connector is configured for engaging a correspondingly configured female receiving portion on either of</b></p> <p><b>the second shaft portion or a spacer member.</b></p> <p>14. An apparatus for extending a golf club comprising: at least one spacer member configured for coupling a first portion of a golf club to a second portion of the golf club, and configured for maintaining the integrity of the golf club as an integral member when the first and second golf club portions are coupled together.</p> <p>15...wherein the at least one spacer member includes a first end including <b>a female-type receiving port and a second end including a male-type connector.</b></p> <p>16...<b>additionally comprising: a first portion of a golf club and a second portion of a golf club.</b></p> <p>17...wherein the first portion of a golf club includes a <b>shaft portion in communication with a handle and the</b></p>	<p>Shown in fig. 2.</p> <p>Shown in fig. 2</p> <p>See examiner's treatment of claim 1 above.</p> <p>See treatment of claims 3 and 9 above.</p> <p>See treatment of claims 3 and 8 above.</p> <p>As shown in fig. 2, first portion 22 is in communication with handle portion 2.</p> <p>Second portion 11 is in communication with the head 14.</p> <p>21</p>
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<p><b>shaft portion in communication with a handle and the second portion of the golf club includes a shaft portion in communication with a head.</b></p> <p>18. A <b>spacer member</b> for extending the length of a golf club comprising:</p> <p>a body configured for coupling a <b>first portion</b> of a golf club to a <b>second portion</b> of the golf club, and configured for maintaining the integrity of the golf club as an integral member when the first and second golf club portions are coupled together.</p> <p>19. The apparatus of claim 18, wherein the body includes a first end including a <b>female-type receiving port</b> and a second end including a <b>male-type connector</b>.</p> <p>20. An extensible golf club comprising:</p> <p>a <b>club head</b> presenting a substantially flat ball-striking surface; a <b>handle</b>; and</p> <p>a <b>shaft coupled to the club head</b> and the handle, said shaft including at least <b>one spacer segment operable to selectively adjust the length of the shaft</b>, said shaft being configured to <b>prevent telescopic adjustment</b> of the length thereof.</p> <p>21...said shaft including a <b>normally lower portion</b> coupled to the club head and a <b>normally upper portion</b> coupled to the handle, said spacer segment being <b>adapted to be coupled between the lower portion and the upper portion</b>.</p> <p>22...said shaft being <b>non-retractable</b>.</p>	<p>22</p> <p>11</p> <p>Inherently shown by fig. 1.</p> <p>24 and 25 respectively.</p> <p>14</p> <p>12</p> <p>16</p> <p>21</p> <p>As shown in fig. 2.</p> <p>The club of Hunter cannot operate telescopically.</p> <p>11</p> <p>22</p> <p>Shown in fig. 2.</p> <p>The club of Hunter cannot retract.</p> <p>Shown in fig. 2</p> <p>Shown in fig. 2</p>
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<p>23...said shaft including a <b>plurality of spacer segments</b> operable to selectively adjust the length of the shaft, each of said spacer <b>segments including a first end and a second end, said first end of one of said spacer segments being configured to at least partly abut a second end of an adjacent one of said spacer segments.</b></p> <p>24...said spacer segments <b>being interchangeable.</b></p> <p>25...and a <b>locking mechanism</b> for fixing the spacer segments relative to one another.</p> <p>26...said locking mechanism selected from the group consisting of <b>thread</b>, epoxy, a pin, and combinations of two or more thereof.</p> <p>27...said spacer segments being selectively interconnectable so that multiple spacer segments can be simultaneously used to adjust the length of the shaft.</p>	<p>The segments 21 of Hunter are interchangeable.</p> <p>The treads on 25 are considered to be a locking mechanism for fixing the spacer segments relative to one another.</p> <p>25 shows threads</p>
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In the alternative, claims 1-19 and 21-27 are rejected under 35 U.S.C. 102(b) as being anticipated by Leshner.

As to claims 1-5, 8-10, 13-22 Leshner shows a club head 9, inherently capable of being used to strike a golf ball, handle 5 and shaft with sections 1, 7 and 8. As to claims 6, 7, 11 and 12, element 11 is considered to be a "locking mechanism".

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Leshner. Claim 20 calls for a flat surface (the use for ball striking is functional) not shown by Leshner. The shape of Leshner is only critical in that his head 9 is capable of penetrating the ground. To have made the head with flat sides would have been an obvious matter of design choice. This is supported by *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966) (The court held that the configuration of the claimed disposable plastic nursing container was a matter of choice which a person of ordinary skill in the art would have found obvious absent persuasive evidence that the particular configuration of the claimed container was significant.)

### **Conclusion**

Any inquiry concerning this communication and its merits should be directed to William Pierce at E-mail address [bill.pierce@USPTO.gov](mailto:bill.pierce@USPTO.gov) or at telephone number (703) 308-3551.

Any inquiry not concerning the merits of the case such as **missing papers, copies, status or information** should be directed to Tech Center 3700 Customer Service Center at (703) 306-5648 where the fax number is (703) 308-7957 and the email is [Customerservice3700@uspto.gov](mailto:Customerservice3700@uspto.gov).

For **official fax** communications to be officially entered in the application the fax number is (703) 305-3579.

For **informal fax** communications the fax number is (703) 308-7769.

Any inquiry of a general nature or relating to the **status** of this application or proceeding can also be directed to the receptionist whose telephone number is (703) 308-1148.

Any inquiry concerning the **drawings** should be directed to the Drafting Division whose telephone number is (703) 305-8335.



WILLIAM M. PIERCE  
PRIMARY EXAMINER